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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,631	04/15/2004	Toshiyasu Yabe	9683/187	8998

7590 04/11/2008  
Brinks Hofer Gilson & Lione  
NBC Tower, Suite 3600  
P.O. Box 10395  
Chicago, IL 60610

EXAMINER
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GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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04/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/825,631	<b>Applicant(s)</b> YABE ET AL.	
	<b>Examiner</b> Gerald Gauthier	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/15/04, 8/16/06, 5/22/06, 2/21/06</u> .                      | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Salzfass et al (US 2002/0042815 A1) in view of Amir et al. (US 2003/0055902 A1).

Regarding **claim 1**, Salzfass discloses an e-mail management apparatus [A system for routing undeliverable e-mail messages, paragraph 0001], comprising:

a first storage unit for storing a record including one or more e-mail accounts provided to a customer and a corresponding terminal identifier for identifying a communication terminal carried by the customer [The DNS 18 is the storage unit including e-mail accounts and addresses, paragraph 0044];

means for receiving e-mails [The client recipient machine 19 received the e-mail If the name is validated, paragraph 0044];

a second storage unit comprising a storage location corresponding to a terminal identifier, wherein e-mails received by the receiving means are stored in the storage location corresponding to the terminal identifier included in a record stored in the first storage unit, and the record is designated by the e-mail account corresponding to a destination e-mail address of the e-mail [The database 170 includes the e-mail accounts and record of email's destinations, paragraph 0052];

first transmission means for transmitting a received e-mail to the communication terminal designated by the terminal identifier included in the record stored in the second storage unit corresponding to the e-mail account, when the e-mail account corresponding to the destination e-mail address of the received e-mail is active [The outgoing e-mail server 14 transmits the e-mail to the appropriate e-mail address, paragraph 0055]; and

second transmission means for transmitting the e-mail stored in the second storage unit corresponding to the terminal identifier of a communication terminal carried

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by the customer to the communication terminal [The DB+FS will send a notification to the current e-mail address to indicated that the-mail has been readdressed is the storage unit including e-mail accounts and addresses, paragraph 0061].

Salzfass fails to disclose means for changing the status of an e-mail account to active in response to a request by the customer.

However, Amir teaches means for changing the status of an e-mail account to active in response to a request by the customer, the e-mail account being included in the record stored in the first storage unit [The user accesses the remote access e-mail client to select an account, thereby change the status of the account to active, paragraph 00r6].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Salzfass using the status information of e-mail as taught by Amir.

This modification of the invention enables the system to have a means for changing the status of an e-mail account to active so that the user would receive the e-mail data.

Regarding **claim 2**, Salzfass discloses an e-mail management apparatus, wherein a set of text data is generated from the e-mails stored in the second storage unit [The outgoing e-mail server 14 construct an error message, which is a text data, paragraph 0047]; and

the set of text data is transmitted to the communication terminal designated by the terminal identifier corresponding to the storage location for storing the e-mails to a set of to be evaluated by using a browsing function, the second transmission means transmitting the text data to the communication terminal designated by the terminal identifier [The error message is transmitted according to the e-mail identifier for the intended recipient, paragraph 0049].

Regarding **claim 3**, Salzfass discloses an e-mail management apparatus, wherein the second transmission means notifies a list of titles of the e-mails stored in the storage location to the communication terminal designated by the terminal identifier corresponding to the storage location [The outgoing e-mail server 14 transmits the e-mail to the appropriate e-mail address, paragraph 0052]; and

the second transmission means forwards e-mails selected by the customer from among the list of titles of the e-mails in response to the transmission from the communication terminal [The outgoing e-mail server 14 transmits the e-mail to the appropriate e-mail address, paragraph 0055].

Regarding **claim 4**, Salzfass discloses an e-mail management apparatus, further comprising authentication means for authenticating a customer who requests a forwarding of the e-mails stored in the second storage unit [The incoming e-mail server 20 validating the name in the address field of the message, paragraph 0044],

wherein the second transmission means transmits the e-mails stored in the second storage unit to the communication terminal carried by the customer, when the terminal is authenticated by the authentication means [The incoming e-mail server 20 transmits the e-mail to the appropriate e-mail address, paragraph 0044].

Regarding **claim 5**, Amir teaches an e-mail management apparatus, wherein the communication terminal is configured as a mobile phone [The handheld appliance 32 is used to retrieve e-mail message, paragraphs 0030 and 31]; and

a telephone number assigned to the mobile phone is used as the terminal identifier which is stored in the first storage unit [The handheld appliance 32 is used to retrieve e-mail message, paragraphs 0030 and 31].

Regarding **claim 6**, Salzfass in combination with Amir disclose all the limitations of claim 6 as stated in claim 1's rejection above.

Furthermore, Salzfass discloses forwarding, in response to a request, the e-mails received in the receiving step and addressed to destination e-mail addresses corresponding to at least one inactive e-mail account [The DB+FS 170 gives the intended recipient the choice of on demand setting thereby responding to the request of the recipient to deliver the e-mail message after the error notification of bad e-mail address, paragraph 0060].



***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lebouill is cited for a system managing subscriber information.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

/GG/  
April 11, 2008